UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/014,525	01/28/1998	MICHAEL SASUTA	CM02261H	4610

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EXAMINER
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ART UNIT	PAPER NUMBER
2666	

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Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.		Applicant(s)
Office Action Summary	09/014,525		SASUTA ET AL.
	Examiner		**Art Unit**
	Frank Duong		2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _10/03/04_.

2a)☒ This action is **FINAL**.　　　2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-23 and 32-55_ is/are pending in the application.

　　4a) Of the above claim(s) _13-23 and 32-48_ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-12 and 49-55_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　　a)☐ All b)☐ Some * c)☐ None of:

　　　1.☐ Certified copies of the priority documents have been received.

　　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　　* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

　　a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)　　　　4)☐ Interview Summary (PTO-413) Paper No(s). _____.

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)　　5)☐ Notice of Informal Patent Application (PTO-152)

3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.　　6)☐ Other: _____.

DETAILED ACTION

1. This Office Action is a response to the amendment dated 10/03/2003. Elected

Claims 1-12, 49-59 and non-elected claims 13-23 and 32-48 are pending in the

application. Non-elected claims 13-23 and 32-49 were withdrawn from further

consideration per Office Action dated 10/22/02. In a response to this Office Action,

Applicants should cancel the non-elected claims to expedite the prosecution, should the

response place the application in condition for allowance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-12 and 49-55 are rejected under 35 U.S.C. 102(e) as being anticipated by

Pepe et al (USP 5,742,668) (hereinafter "Pepe").

Regarding **claim 1**, in accordance with Pepe reference entirety, Pepe discloses

in a communication system (Fig. 4) that includes a service provider (48) and a

subscribers (30), a method for processing services comprises the steps of:

indicating to the subscriber that the service provider is capable of supporting a

service (*see col. 16, lines 36-50*);

receiving service processing logic from the subscriber to allow the service

provider to provide the service (see col. 18, lines 1-16 and col. 19, line 66 to col. 20, line

52);

executing the service processing logic received from the subscriber to provide

the service to the subscriber based on the service processing logic when the service

has been requested (*see col. 18, lines 16-20*).

Regarding **claim 2**, in addition to features recited in base claim 1 (*see rationales*

pertaining the rejection of base claim 1 discussed above), Pepe further discloses

wherein the step of indicating is performed upon receipt of at least one of: a service

registration from the subscriber and a service invocation from the subscriber (*see col.*

16, lines 36-50).

Regarding **claim 4**, in addition to features recited in base claim 1 (*see rationales*

pertaining the rejection of base claim 1 discussed above), Pepe further discloses within

receiving an indication of service requirements of the one of the plurality of subscribers

by the service provider; and determining whether the service provider is capable of

supporting the at least one service base on the indication by the service provider (see

col. 16, lines 1-51).

Regarding **claim 5**, in addition to features recited in base claim 1 (*see rationales*

pertaining the rejection of base claim 1 discussed above), Pepe further discloses the

step of storing a service application, and wherein the service processing logic

comprises custom user parameters, wherein the custom user parameters modify the

service application to meet customization requirement of the subscriber (*see col. 19,*

line 66 to col. 20, line 52, Pepe discloses the subscriber profile download and modifying

process and col. 26, line 4 to col. 27, line 34 for PDA application).

Regarding **claim 6**, in addition to features recited in base claim 1 (*see rationales*

pertaining the rejection of base claim 1 discussed above), Pepe further discloses the

service processing logic comprises a service application and custom user parameters

that relate to the service (*see col. 19, line 66 to col. 20, line 52 and col. 26, line 4 to col.*

27, line 34).

Regarding **claim 7**, in addition to features recited in base claim 6 (*see rationales*

pertaining the rejection of base claim 6 discussed above), Pepe further discloses

queuing the at least one service when at least one of: the service provider has

insufficient processing and memory and the communication system has insufficient

communication resources (*see col. 23, line 38 to col. 24, line 64 for the handling of*

wireless messaging).

Regarding **claim 8**, in addition to features recited in base claim 1 (*see rationales*

pertaining the rejection of base claim 1 discussed above), Pepe further discloses

deleting the service processing logic by the service provider based on deletion

parameters, wherein the deletion parameters comprise at least one of: a time out

period, service priority, processing and memory availability, number of times that at

least one service has been executed exceed a threshold, and lack of activity (*see col.*

17, lines 6-63 for deregistration process).

Regarding **claim 9**, in addition to features recited in base claim 1 (*see rationales*

pertaining the rejection of base claim 1 discussed above), Pepe further discloses the

steps of: receiving a command from the subscriber; and disabling the service

processing logic in response to the command when the subscriber is authorized to

command disablement of the service processing logic (*see col. 17, lines 6-63 for

deregistration process*).

Regarding **claim 10**, in addition to features recited in base claim 9 (*see

rationales pertaining the rejection of base claim 9 discussed above*), Pepe further

discloses the step of disabling the service processing logic by at least one of: erasure

and inactivation (*see col. 17, lines 6-63 for deregistration process*).

Regarding **claim 11**, in addition to features recited in base claim 10 (*see

rationales pertaining the rejection of base claim 10 discussed above*), Pepe further

discloses the step of, when the service processing logic was disabled by inactivation,

subsequently receiving a second command from the subscriber to reactivate the service

processing logic (*see col. 17, lines 6-63 for deregistration process*).

Regarding **claim 12**, in addition to features recited in base claim 1 (*see

rationales pertaining the rejection of base claim 1 discussed above*), Pepe further

discloses the step of receiving authentication from the subscriber to allow the service

provider to support the service (*see col. 15, lines 9-11*).

Regarding **claim 55**, in addition to features recited in base claim 1 (*see

rationales pertaining the rejection of base claim 1 discussed above*), Pepe further

discloses the steps of: receiving a request for the service from a second subscriber (32

or 34); and executing the service processing logic received from the subscriber to

provide the service to the second subscriber (see Fig. 1 and col. 5, lines 5-30).

Regarding **claim 49**, in accordance with Pepe reference entirety, Pepe discloses

in a communication system (Fig. 4) that includes a service provider (48) and a plurality

of subscribers (30-34), a method for processing services comprises the steps of:

determining that the service provider is capable of supporting a service (*see col.

16, lines 36-50*);

sending service processing logic to the service provider to allow the service

provider to provide the service (see col. 18, lines 1-16 and col. 19, line 66 to col. 20, line

52);

receiving the service processing logic based on the service processing logic

received from the service provider when the service has been requested (*see col. 18,

lines 16-20*).

Regarding **claim 3**, in addition to features recited in base claim 49 (*see

rationales pertaining the rejection of base claim 49 discussed above*), Pepe further

discloses within receiving an indication of service requirements of the one of the

plurality of subscribers by the service provider; and determining whether the service

provider is capable of supporting the at least one service base on the indication by the

service provider (see col. 16, lines 1-51).

Regarding **claim 50**, in addition to features recited in base claim 49 (*see

rationales pertaining the rejection of base claim 49 discussed above*), Pepe further

discloses wherein the service processing logic comprises custom user parameters,

wherein the custom user parameters modify the service application to meet

customization requirement of the subscriber (*see col. 19, line 66 to col. 20, line 52,

Pepe discloses the subscriber profile download and modifying process and col. 26, line 4 to col. 27, line 34 for PDA application).

Regarding **claim 51**, in addition to features recited in base claim 49 (*see rationales pertaining the rejection of base claim 491 discussed above),* Pepe further discloses the service processing logic comprises a service application and custom user parameters that relate to the service (*see col. 19, line 66 to col. 20, line 52 and col. 26, line 4 to col. 27, line 34).*

Regarding **claim 52**, in addition to features recited in base claim 49 (*see rationales pertaining the rejection of base claim 491 discussed above),* Pepe further discloses sending an indication of service requirement to the service provider (see col. 15, lines 1-11).

Regarding **claim 53**, in addition to features recited in base claim 49 (*see rationales pertaining the rejection of base claim 491 discussed above),* Pepe further discloses the step of sending a disable command to the service provider to disable the service provider from providing the service based on the service processing logic (see col. 17, lines 7-63).

Regarding **claim 54**, in addition to features recited in base claim 49 (*see rationales pertaining the rejection of base claim 491 discussed above),* Pepe further discloses the step of authenticating the service provider to allow the service provider to support the service with the service processing logic (*see col. 15, lines 9-11).*

Response to Arguments

3. Applicant's arguments filed 10/03/2003 have been fully considered but they are not persuasive. Applicants' arguments will be addressed hereinbelow in the order in which they appear in the response filed 10/03/02.

In the Remarks of the outstanding response, on pages 6-7, pertaining the rejection of claims 1-12 and 49-55, Applicants asserts Pepe "fails to disclose the service provider receiving service processing logic from the subscriber ..., and executing the service processing logic received from the subscriber to provide the service to the subscriber". To support the allegation, Applicants further state "Pepe discloses an internetwork that interconnects messaging services with both wireless and wireline networks ... Pepe teaches away from the present invention because the subscriber in Pepe does not provide new service processing logic directly to the service provider to be executed on behalf of the subscriber".

In response Examiner respectfully disagrees for the following rationales.

First, Applicants fail to recognize or address Examiner's position in the Office Action. Pepe, as clearly pointed out in the Office Action, discloses PCI server 48 (corresponding to "service provider") receive e-mail notification (corresponding to "service processing logic") from PDA 30 (corresponding to "subscriber") (col. 18, lines 1-16). PCI server 48 acknowledges the notification and provides PDA 30 the e-mail service. Since there is no specific definition for the term "service processing logic" in the claims, Examiner asserts the interpretation of Pepe's "e-mail notification" from PDA

30 to correspond to the "service processing logic" is proper and just. Therefore, in light

of the claim language, Examiner is content Pepe discloses the ***claimed invention***.

Second, after a careful review the disputed claims, Examiner finds no such

language of "*the subscriber provides new service processing logic directly to the service*

provider to be executed on behalf of the subscriber". Perhaps applicants refer to certain

features that are disclosed in the present application but not recited in the rejected

claims in making the contention that the Pepe reference fails to show certain feature of

applicants' invention. Applicants are reminded that although the claims are interpreted

in light of the specification, limitations from the specification are not read into the claims.

See *In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)*.

Examiner believes an earnest attempt has been made in addressing all of the

Applicants' arguments. Due to the arguments are not persuasive, the rejection from the

last Office Action is maintained.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Frank Duong whose telephone number is (703) 308-

5428. The examiner can normally be reached on 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Seema Rao can be reached on (703) 308-5463. The fax phone number for

the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 305-

4700.

Frank Duong
Examiner
Art Unit 2666

January 9, 2004